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OFFICE OF PETITIONS

In re Application of: :
Kyoji Sekiguchi :
Application No. 10/820369 : ON PETITION
Filing or 371(c) Date: 04/08/2004 :
Attorney Docket Number: 1232-5368 :

This Decision is in response to the Petition and Request Under 35 U.S.C. § 254 for Issuance of Corrected Patent,” filed July 14, 2008. The request is properly treated as a petition under 37 CFR 1.181.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled “Renewed Petition under [insert the applicable code section].” This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Petitioner files the present petition to correct the name of the inventor from Kiyoji Sekiguchi to Kyoji Sekiguchi. Petitioner asserts that the nature of the error is such that a Certificate of Correction is inappropriate in form because there is a tendency for Certificate of Correction to become separated from printed copies of the patent, and that patents in electronic media may not always be accompanied by their corresponding certificate of Correction. Therefore, the issuance of a corrected patent is more appropriate due to the substantive nature of the error.

Applicable Law, Rules and MPEP

37 CFR 1.322, Certificate of correction of Office mistake.

(a)

(1) The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee’s assignee;

(ii) Acting sua sponte for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2)

- (i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.
- (ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.
- (3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.
- (4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.
- (b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

The MPEP 1480 explains as follows:

Mistakes incurred through the fault of the Office may be the subject of Certificates of Correction under 37 CFR 1.322. The Office, however, has discretion under 35 U.S.C. 254 to decline to issue a Certificate of Correction even though an Office mistake exists. If Office mistakes are of such a nature that the meaning intended is obvious from the context, the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it subsequently arises. Such is the case, even where a correction is requested by the patentee or patentee's assignee.

In order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Instead of a request for a Certificate of Correction, letters making errors of record should be utilized whenever possible. Thus, where errors are of a minor typographical nature, or are readily apparent to one skilled in the art, a letter making the error(s) of record can be submitted in lieu of a request for a Certificate of Correction. There is no fee for the submission of such a letter.

The MPEP 605.04(b), in discussing corrections of the spelling of an inventor's name, provides:

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee. Since amendments are not permitted after the payment of the issue fee (37 CFR 1.312), a petition under 37 CFR 1.182 to change the name of the inventor cannot be granted if filed after the payment of the issue fee. The petition should be directed to the attention of the Office of Petitions. Upon granting of the petition, if the application is maintained in paper, the left margin of the original oath or declaration should be marked in red ink "See paper No. ____ for correction of the inventor's name,"

and the application should be sent to the Office of Initial Patent Examination (OIPE) for correction of its records, unless the application is an application with an application data sheet (e.g., an 09/ series application), in which case the Office of Petitions will correct the Office computer records and print a new bibliographic data sheet. If the application is assigned, it will be forwarded by OIPE or the Office of Petitions to the Assignment Division for a change in the assignment record.

When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. However, applicants are strongly encouraged to use an application data sheet such that any patent to issue will reflect the correct spelling of the inventor's name. Without an application data sheet with the corrected spelling, any patent to issue is less likely to reflect the correct spelling since the spelling of the inventor's name is taken from the oath or declaration, or any subsequently filed application data sheet.

If the error is not detected until after the payment of the issue fee, because amendments are not permitted after the payment of the issue fee, either (A) the application must be withdrawn from issue under 37 CFR 1.313(c)(2) and a request to correct the spelling of the inventor's name submitted with a request for continued examination (RCE) under 37 CFR 1.114, or (B) a certificate of correction must be filed after the patent issues requesting correction of the spelling of the inventor's name.

Analysis

Applicant asserts that the error, the misspelling of the inventor's given name as Kiyoji, instead of Kyoji, is a substantive error. However, the MPEP differentiates between minor errors, and substantive errors. The analysis is whether the error is of such a nature that the meaning intended is obvious from the context. Here, the error asserted is the misspelling of the inventor's given name as Kiyoji, instead of Kyoji. Where the error is of such a nature that the meaning intended is obvious from the context, as stated above, "the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it subsequently arises. Such is the case, even where a correction is requested by the patentee or patentee's assignee." The MPEP further states that "[i]n order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Instead of a request for a Certificate of Correction, letters making errors of record should be utilized whenever possible. Thus, where errors are of a minor typographical nature, or are readily apparent to one skilled in the art, a letter making the error(s) of record can be submitted in lieu of a request for a Certificate of Correction.

The error asserted in the present case, is that the inventor's given name incorrectly appears on the patent as Kiyoji, instead of Kyoji. Such an error is of a minor, typographical nature.

Further to this, the MPRP 605 states that a certificate of correction must be filed after the patent issues requesting correction of the spelling of the inventors name. The correction of the spelling of an inventors name as a result of a typographical error is a minor error, the remedy for which is a Certificate of Correction.

Regarding Petitioner's assertions, that there is a tendency for Certificate of Correction to become separated from printed copies of the patent, and that patents in electronic media may not always be accompanied by their corresponding certificate of Correction, Petitioner has not provided any documentary support for these (bald) assertions.

Conclusion

Applicant has failed to demonstrate that a Certificate of Correction is not the appropriate remedy to correct the spelling of the inventors name.

The application is being referred to the Certificate of Corrections Branch for consideration of the Request for Certificate of Correction filed July 14, 2008.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
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